

**REMARKS**

This Amendment, filed in reply to the Office Action dated September 6, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-12 are all the claims pending in the application.

**I. Claim Rejections under 35 U.S.C. § 112**

Claim 12 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A proposed correction is set forth above. Additional corrections are submitted to correct antecedent basis in the claims. Applicant submits that the modifications should be entered because they do not raise any new issues in need of further consideration.

**II. Claim Rejections under 35 U.S.C. § 102**

Claims 1-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Akagi (U.S. Patent No. 6,931,421).

**III. Claim Rejections under 35 U.S.C. § 103**

Claims 6-7 and 11-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Akagi (U.S. Patent No. 6,931,421) in view of Tipirneni (US Pub. No. 2004/0257608).

Claims 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Akagi (U.S. Patent No. 6,931,421) in view of White et al. (US Pub. No. 2004/0019501).

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Akagi (U.S. Patent No. 6,931,421) in view of Banks et al. (US Patent No. 6,603,494).

Applicant respectfully submits the following arguments in traversal of the prior art rejections.

The Examiner essentially maintains the same rational for rejecting prior pending claims 1-7 and offers a few points in rebuttal. As a first basis of rebuttal, the Examiner refuses to accord patentable significance to the recitation in the preamble of claim 1. Applicant submits that the Examiner's contention with respect to the preamble recitations of claim 1 are in error and that the claims should be patentable based on features of the "merging data of the image obtained by said medical imaging apparatus and the examinational information data from said server into data in a predetermined format" as set forth in the Amendment filed on June 14, 2006.

Moreover, the Examiner also contends that with respect to independent claim 1, the claim is directed to an intended use and such recitations are not afforded any patentable weight. In particular, the Examiner contends that recitations of a step "occurring `when' something else occurs carries no patentable weight." Applicant submits that these contentions are legally incorrect.

First, the Examiner is misapplying the doctrine of intended use. Intended use applies when a known structure is described as being used for a particular application. This is not the situation here when the structural aspects within the body of the claim define a unique structure. Second, the Examiner's reference to a "step occurring when something else occurs" appears to be misplaced. Claim 1 is an apparatus claim, not a method claim where a "step" may or may not occur. Similarly, claim 5 is a system claim, and thus the reference to a "step" appears to be inappropriate. Third, the U.S.P.T.O. has long recognized the patentable weight to be afforded to

recitations even if conditional. See Ex parte Van Tunen, 67 USPQ2d 1518, 1525 (BPAI 2003).

The conditional recitation in the current claims is related to a structural or operable feature of a claimed structure and thus is appropriately given patentable weight. Such conditional features would dictate the nature of data as managed on a medium, Ex parte Lowry, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994). Therefore, the conditional recitation should be give patentable weight.

In the present situation, claim 1 recites "comparing means for comparing examinational information data newly read from said server and examinational information data that have already been stored in said local database with each other, and storing the newly read examinational information data into said local database only when the newly read examinational information data have not been stored in said local database." The underlined portion comprises a limitation on the operation of the means-plus-function element and thus should be afforded patentable weight.

To the extent that the Examiner continues to rely on col. 5, lines 45-49 of Akagi to teach the above underlined feature, the cited portion merely teaches an update of order information. The recitation does not relate to data being stored to a local data base "only when" the data has not been stored in the local database. In fact, Akagi contemplates a situation of incorrect updating and seeks timing control to compensate. Col. 5, lines 50-58. The updating of order information in Akagi does not necessitate the operational condition as described by claim 1.

Therefore, Applicant maintains that claim 1 is patentable over Akagi. Claim 5 is patentable for analogous reasons.

With regard to claim 10, this claim specifically describes within the body of the claim, "a data processing apparatus for merging data ... into data in a predetermined format". Therefore, the Examiner's statement that indicates such a feature is not claimed (last full paragraph of page 14) is in error.

The Examiner rejects claim 10 over the combination of Akagi and Banks. For the above recitation of claim 10, the Examiner refers to col. 15, lines 16-27 of Banks. The cited portion relates to an icon tool for viewing image data once collected. There is no teaching of merger of examinational (identification) information data from a server and medical imaging data into a predetermined format. Therefore, claim 10 is patentable for this additional reason.

The remaining claims are patentable based on their dependency on claims 1 or 5. Tipirneni does not make up for the above deficiencies of Akagi.

With further regard to claim 8, this claim describes that the medical imaging apparatus sends an end signal to the server, and the server deletes examinational information data when the end signal is received. The Examiner refers to paragraphs 57-59 of White to teach this feature. The Examiner apparently relies on the report generation provided by a radiologist and transmission of reports to the transcriptionist to teach this feature. However, in White, the deletion of records, for example, is provided at the behest of the radiologist rather than by the apparatus. Applicant submits that the operations provided by an operator are insufficient to provide teachings for an apparatus claim. In re Bell, 26 USPQ2d 1529 (Fed. Cir. 1993); see also Hewlett-Packard Co. v. Mustek Systems Inc., 67 USPQ2d 1825, 1829-30 (CA FC 2003). Claim 9 is patentable based on its dependency.

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 10/665,140

**Attorney Docket No. Q77096**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

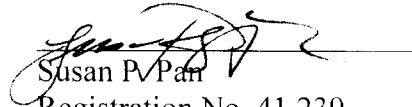
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**23373**

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